

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael WELLER et al.

Patent No.: 7,531,575

Confirmation No. 1173

Issue Date: May 12, 2009

Art Unit: 1611

Serial No.: 10/697,655

Examiner: Kortney L. KLINKEL

Filed: October 31, 2003

For: **A METHOD OF MODULATING CELLULAR ACTIVITY AND AGENTS  
USEFUL FOR SAME**

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Commissioner for Patents  
**Mail Stop Petitions**  
P.O. Box 1450  
Alexandria, VA 22313-1450

## **REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§1.704 & 1.705**

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on May 12, 2009 as U.S. Patent No. 7,531,575. This request is timely filed within 2 months from the date of issue as July 12, 2009 is a Sunday, thus making today, July 13, 2009, the timely response date.

The USPTO determined that the patent was entitled to 1186 days of PTA. See attached USPTO PTA calculation. Applicants believe that this PTA determination was made in accordance with the USPTO's interpretation of the "Explanation of 37 CFR §1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (June 21, 2004). Under that interpretation of the PTA statute, any USPTO delay under 35 U.S.C. §154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. §154(b)(1)(B), and so as a practical effect, PTA may be awarded under 35 U.S.C. §154(b)(1)(A) or 35 U.S.C. §154(b)(1)(B), but never both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision holding that the USPTO's interpretation of the PTA statute was incorrect. See *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that the PTA statute should properly be interpreted so that "the only way that periods of time can overlap is if they occur on the same day." *Wyeth*, slip op. at 8. Thus, *Wyeth* holds that a USPTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." *Id.* Applicants are aware that this district court decision has been appealed to the U.S. Court of Appeals for the Federal Circuit (CAFC) but that no decision has yet been issued. Applicants, therefore, request that a decision on this request be delayed until the CAFC decides this appeal.

Applicants have recalculated the PTA for the above-identified patent under the court's interpretation of the PTA statute in *Wyeth*, and have determined that the patent is entitled to 1593 days PTA, when taking into account the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b). There was a 1186 day delay by the USPTO under 35 U.S.C. §154(b)(1)(A) ("A Delay") and a 924 day delay by the USPTO under 35 U.S.C. §154(b)(1)(B) ("B Delay"), which should be added together totaling 2110 combined days minus any physically overlapping PTO delays (517 days) under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) which equals 1593 minus any Applicants' delay.

(a) Total of PTO delay under §154(b)(1)(A) & (B):	2110 days
(b) Total of overlapping PTO delay under §154(b)(1)(A) & (B):	517 days
(c) Total Applicant delay:	---- days
Final PTA Determination:	1593 days – Applicants' delay

Applicants submit that its delay is determined by the events that occurred during the long prosecution of this application and the interpretation of these events under the rules outlined in 37 CFR § 1.704. In this regard, the attached USPTO PTA calculation shows that the USPTO determined that Applicants had 0 days of PTA delay. Based on this premise, Applicants provide the following comments and alternative analyses to calculate Applicants' delay to be further

subtracted from the 1593 PTA days to be awarded to Applicant under the Wyeth district court decision.

Applicants submit that the calculation of 0 days of Applicants' delay is supported by the withdrawal on September 26, 2007 of a previously sent Notice of Abandonment mailed on December 3, 2004, which was sent in error. With regard to later events during prosecution, Applicants request that the USPTO review the calculations from the non-final rejection mailed on July 9, 2008 until a supplemental response was filed on December 2, 2008. Applicants suggest that the USPTO consider a possible 54 day Applicant delay as a result of these prosecution events.

Alternatively, Applicants offer another analysis: that the USPTO reconsider whether there was additional Applicant delay under 37 CFR §1.704 (c)(4), which reduces Applicants' PTA time by a "failure to file a petition ... to revive an application within two months from the mailing of the notice of abandonment, ... beginning on the day two months after the mailing date of the notice of abandonment and ending on the date a petition ... to revive the application was filed." In support of this alternative position, Applicants suggest that the delay could be considered to occur from February 3, 2005 until October 10, 2006 [614 days] plus 54 days, as mentioned above, for a possible total of 668 days of Applicants' delay.

Although not considered to be a viable further analysis and certainly not advocated by Applicants, a further possible interpretation would be under 37 CFR §1.704 (c)(3), which reduces Applicants' PTA time by an "abandonment of the application . . . beginning on the date of abandonment . . . and ending on the date of that is four months after the date that the grantable petition was filed to revive the application." The calculations for this further analysis would consider Applicants' delay from May 20, 2004 until February 10, 2007 [996 days] plus 54 days, as mentioned above, for a possible total of 1050 days of Applicants' delay. Again, Applicants submit that the USPTO withdrew the Notice of Abandonment, which further supports the inapplicability of this rule to the PTA calculations of the present patent.

In support of the analyses above, Applicants wish to point out the following specific dates and actions:

March 19, 2004	Notice of Missing Parts mailed by USPTO
May 20, 2004	Date Application Abandoned [see decision on petition]
Dec 3, 2004	Notice of Abandonment mailed by USPTO
Oct 10, 2006	Petition to Revive Abandoned Application filed by Applicant
March 9, 2007	Decision on Petition to Revive Granted by USPTO
Sept 26, 2007	Withdrawal of previous Notice of Abandonment mailed and new Notice of Missing Parts mailed by USPTO

In accordance with MPEP 2733, Applicants believe that this request is in compliance with its duty of candor and good faith in its practice before the USPTO. Applicants elect to disclose these alternative analyses at this time rather than later so that all PTA recalculation issues can be resolved at the same time, assuming Wyeth appeal to the CAFC has been decided.

Applicants again reiterate that the PTA calculations support Applicants' position that it has only 54 days delay or alternatively under 37 CFR §1.704 (c)(4), it has only 668 days of delay that may further be subtracted from the 1593 days of Wyeth PTA calculations. Further, Applicants reiterate that 1050 days of delay is not the correct analysis to finally calculate Applicant's final delay. Applicants' respectfully request that the USPTO review these analyses and provide a revised PTA calculation with regard to the present patent.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-0815, order number NGIO-001.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number NGIO-001.

Respectfully submitted,  
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LLP

Date: July 16, 2009

By: 

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10/697,655	METHOD OF MODULATING CELLULAR ACTIVITY AND AGENTS USEFUL FOR SAME	03-05-2009::15:04:58
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**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/697,655

Filing or 371(c) Date:	10-31-2003	USPTO Delay (PTO) Delay (days):	1186
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	0
Post-Issue Petitions (days):	+0	Total PTA (days):	1186
USPTO Adjustment(days):	+0	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
01-02-2009	Mail Notice of Allowance		
12-31-2008	Document Verification		
12-03-2008	Examiner Interview Summary Record (PTOL - 413)		
12-31-2008	Examiner's Amendment Communication		
12-31-2008	Notice of Allowance Data Verification Completed		
12-31-2008	Case Docketed to Examiner In GAU		
08-27-2008	Electronic Information Disclosure Statement		
12-08-2008	Date Forwarded to Examiner		
12-02-2008	Supplemental Response		
08-27-2008	Information Disclosure Statement considered		
09-15-2008	Information Disclosure Statement considered		
10-04-2008	Case Docketed to Examiner In GAU		
09-15-2008	Electronic Information Disclosure Statement		
09-15-2008	New or Additional Drawing Filed		
09-24-2008	Date Forwarded to Examiner		
09-15-2008	Response after Non-Final Action		
09-03-2008	Miscellaneous Incoming Letter		
09-15-2008	Information Disclosure Statement (IDS) Filed		
09-10-2008	Mail Examiner Interview Summary (PTOL - 413)		
09-05-2008	Examiner Interview Summary Record (PTOL - 413)		
08-27-2008	Information Disclosure Statement (IDS) Filed		
07-09-2008	Mail Non-Final Rejection		
07-07-2008	Non-Final Rejection		
06-24-2008	Case Docketed to Examiner In GAU		
06-18-2008	Date Forwarded to Examiner		
06-16-2008	Response to Election / Restriction Filed		
06-16-2008	Request for Extension of Time - Granted		
05-01-2008	PG-Pub Issue Notification		
03-31-2008	Mail Restriction Requirement	1186	
03-27-2008	Requirement for Restriction / Election	↑	
03-09-2008	Case Docketed to Examiner In GAU	↑	

03-08-2008	Case Docketed to Examiner in GAU	↑
03-06-2008	IFW TSS Processing by Tech Center Complete	↑
12-26-2007	Preliminary Amendment	↑
10-10-2006	Preliminary Amendment	↑
02-07-2008	Application Dispatched from OIPE	↑
01-25-2008	Sent to Classification Contractor	↑
01-25-2008	Filing Receipt - Updated	↑
01-25-2008	Application Is Now Complete	↑
12-26-2007	Additional Application Filing Fees	↑
12-26-2007	CRF Disk Has Been Received by Preexam / Group / PCT	↑
01-10-2008	CRF Is Good Technically / Entered into Database	↑
11-14-2007	Filing Receipt - Corrected	↑
09-26-2007	SEQUENCE ERRORS	↑
10-10-2006	Payment of additional filing fee/Preexam	↑
10-10-2006	A set of symbols and procedures, provided to the PTO on a set of computer listings, that describe in	↑
10-10-2006	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑
10-10-2006	Applicant has submitted new drawings to correct Corrected Papers problems	↑
10-10-2006	Applicant has submitted a new specification to correct Corrected Papers problems	↑
12-03-2004	Withdraw Pre-Exam Abandon	↑
08-20-2007	Correspondence Address Change	↑
08-20-2007	Change in Power of Attorney (May Include Associate POA)	↑
03-09-2007	Mail-Petition to Revive Application - Granted	↑
10-10-2006	Petition Entered	↑
05-20-2004	Abandonment -- During Preexam Processing	↑
02-05-2004	Cleared by L&R (LARS)	↑
01-22-2004	Referred to Level 2 (LARS) by OIPE CSR	↑
12-13-2003	IFW Scan & PACR Auto Security Review	↑
10-31-2003	Initial Exam Team nn	↑

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